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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/859,615	05/16/2001	George W. Landry	MPS / 30DV3	4415
26875	7590	10/10/2006	EXAMINER	
WOOD, HERRON & EVANS, LLP 2700 CAREW TOWER 441 VINE STREET CINCINNATI, OH 45202			KESACK, DANIEL	
			ART UNIT	PAPER NUMBER
			3691	

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/859,615	LANDRY, GEORGE W.	
	Examiner	Art Unit	
	Dan Kesack	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/27/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This application has been reviewed. Original claims 1-24 are currently pending. The rejections are as stated below.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 5,649,117 in view of Lawlor, U.S. Patent No. 5,220,501.

Claims 1-24 additionally recite the payment obligation being a recurring obligation. Lawlor discloses a system and method for delivery of retail banking services, including paying bills, wherein users may configure the automatic payment of recurring bills on a periodic basis. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to include the option of automatic payment of recurring bills because it would be desirable and more convenient to the user to set up automatic payment for static bills which occur for the same amount on a weekly, monthly, or yearly basis.

Similarly, claims 1-24 of the '177 patent recite all other elements of claims 1-24 of the current application.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Kight et al., U.S. Patent No. 5,383,113.

Claim 1, Kight discloses a system and method for electronically providing customer services including payment of bill and loans, comprising:

storage for payee information for each of a plurality of payees (column 3 lines 35-45);

storage for payor information for each of a plurality of payors, said information for each payor including information identifying at least one of said payees authorized to receive a transfer of funds from said payor (column 2 lines 40-64 and column 3 lines 30-35), an obligation amount, wherein the payment may be recurring, in which case the information also includes a minimum time interval (column 3 lines 48-54 and 57-59);

a bill generator for generating at a first time a record from the payor information and payee information, including an obligation amount and payment date so that the generated bill record (customer pay table) corresponds to a transfer of funds between

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one of the payors and one of the payees to pay an obligation amount on a payment date corresponding to a minimum time interval (column 5 lines 31-42 and column 6 lines 52-62); and

a message generator generating at a second time EFT messages corresponding to the generated bill record to effect the transfer of funds (column 5 lines 23-47).

Claim 9, Kight teaches payor information includes payor bank account ID so that the payor may transfer funds between the payor account and an authorized payee (column 2 lines 55-57). Examiner regards the recitation that the account is a government account as an intended use recitation, and therefore is not considered a limitation for patentability.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness

under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
7. Claims 3-5, 11, 13, 14, 16-20, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kight, as applied above, and further in view of Pickering, U.S. Patent No. 5,483,445.

Claim 13, 14, 16, 17, 22 and 23, Kight discloses a system and method for electronically providing customer services including payment of bill and loans, comprising:

storage for payee information for each of a plurality of payees (column 3 lines 35-45);

storage for payor information for each of a plurality of payors, said information for each payor including information identifying at least one of said payees authorized to receive a transfer of funds from said payor (column 2 lines 40-64 and column 3 lines 30-35), an obligation amount, wherein the payment may be recurring, in which case the information also includes a minimum time interval (column 3 lines 48-54 and 57-59);

a bill generator for generating at a first time a record from the payor information and payee information, including an obligation amount and payment date so that the generated bill record (customer pay table) corresponds to a transfer of funds between one of the payors and one of the payees to pay an obligation amount on a payment date corresponding to a minimum time interval (column 5 lines 31-42 and column 6 lines 52-62); and

a message generator generating at a second time EFT messages corresponding to the generated bill record to effect the transfer of funds (column 5 lines 23-47).

Kight fails to teach a communication interface for receiving a bill data message from at least one of said payees, including a payorID and at least one of an obligation amount and a due date.

Pickering discloses an automated bill paying system with periodic electronic transfer of billing information from payees to the bill paying system (abstract). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Kight to include the electronic transfer of billing data directly to the paying system because it would be more convenient to the payor to not have to input the payment information manually, and it would be more efficient for the information to be transferred from the payee.

Claims 3-5, 18, 19, Kight and Pickering fail to teach the bill generator generating error messages in response to received billing parameters which are outside the constraints set by the payor.

Official Notice is taken that the generation of error messages is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify to the teachings of Kight and Pickering to include the generation of error messages in order to alert a user when an amount or time interval is outside the constraints previously established.

Claim 11, Kight teaches generating updated bill records corresponding to EFT messages for effecting a transfer of funds, the updating records being stored in the payor information, and wherein the payor may review an account of fund transfer activity (column 3 line 55 – column 4 line 2).

Claim 20, Kight teaches payor information includes payor bank account ID so that the payor may transfer funds between the payor account and an authorized payee (column 2 lines 55-57). Examiner regards the recitation that the account is a government account as an intended use recitation, and therefore is not considered a limitation for patentability.

8. Claims 2, 6-8, 10, 15, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kight and Pickering, as applied above, and further in view of Calvin's article "Re-engineering the payment process using EDI, ERS and imaging technology".

Claims 2, 6-8, 10, 15, and 21, Kight and Pickering fail to teach the use of EDI forms in transferring information and messages.

Calvin teaches the use of EDI to electronically transfer invoices, bill, receipts, and other business related documents. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Kight and Pickering to include the use of EDI documents because of the efficiency of EDI as described by Calvin.

9. Claims 12 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kight and Pickering, as applied above, and further in view of Hilt, U.S. Patent No. 5,465,206.

Kight and Pickering fail to teach a reversal directive corresponding to a request for a record to be reversed, and a provisional period.

Hilt discloses a system and method for paying bills, wherein reversal messages may be allowed within a specific period of time following a payment (column 8 lines 46-50). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention modify the teachings of Kight and Pickering to include reversal messages because it would provide an efficient way for a payor or payee to correct an mistake in a charge or a payment, if discovered quickly enough.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

